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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,199	08/01/2001	Klaus Hofrichter	80398.P455	6066

7590

04/05/2006

Florin Corie
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
Seventh Floor
12400 Wilshire Boulevard
Los Angeles, CA 90025-1026

EXAMINER

SMITH, TRACI L

ART UNIT

PAPER NUMBER

3629

DATE MAILED: 04/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/921,199	Applicant(s) HOFRICHTER ET AL.	
	Examiner Traci L. Smith	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,7-12, 14-21,24-28, 30,-31, 33, 36-40 and 43-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,7-12, 14-21,24-28, 30,-31, 33, 36-40 and 43-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is in response to papers filed on December 22, 2005.

Claims 1, 4, 7-9, 11-15, 19, 21, 24-25, 30, 33, 36-39, 40, 43-44 have been amended

Claims 48-50 have been added.

Claims 3,5-6, 13, 22-23, 29, 32, 34-35 and 41-42 have been cancelled.

Claims 1,2,4,7-12, 14-21,24-28, 30,-31, 33, 36-40 and 43-50 are pending

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1,2,4,7-12, 14-21,24-28, 30-31, 33, 36-40 and 43-50 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6,86,403 Wiser et al Secure Online Music Distribution.

3. As to claims 1, 9, 19, 30, 38 and 48-49 Wiser teaches requesting a digital file to download over a server, transmitting file identification to content manager and paying for selection(C. 6 I. 65-67 and C. 7 I. 1-5)

4. Wiser further teaches a request for the distribution tool from a client receiving it and applying the tool (C. 8 I. 46-48; 65-67 & C. 9 I. 1-3; 35-30).

5. As to claims 2, 10, 20, 31 and 39 Wiser teaches encrypted files (C. 7 I. 28-29).

6. As to claims 3, 29 and 32 Wiser teaches sending request for the appropriate provider for purchase of identified file(C. 22 I. 3-45).

7. As to claims 4,11-12, 21, 33 and 40 Wiser teaches a distribution tool embedded to identify provider(C. 6 I. 65).

8. As to claims 7, 15, 25, 36and 44 Wiser teaches transmitting distribution tool as a watermark with data(C.7 I. 6-7)

9. As to claims 8, 16, 26, 37 and 45 Wiser teaches making a payment an receiving the decryption(C. 8 I.46-49).

10. As to claims 14, 24 and 43 Wiser teaches storing distribution tool associated with purchaser(C. 8 I. 46-48).

11. As to claims 17-18, 27-28 and 46-47 Wiser teaches teaches authoring fees and reporting rights of payments.(C. 9 I. 47-50).

12. As to claim 50 Wiser teaches a transaction ID that identifies the files and payment of a media file(C. 8 I. 1-2).

Response to Arguments

13. Applicant's arguments filed December 22, 2006 have been fully considered but they are not persuasive. Examiner notes that applicant failed to overcome prior art rejections. Applicant stated they "reserved the right to challenge reference at a later date". In order to over a come a prior art rejection applicant must properly filed affidavit

under 1.131 Affidavit or declaration of prior invention. As applicant failed to challenge prior art reference it is deemed to read on the invention, therefore rejection is maintained as stated above.

14. Applicant states Wiser does not teach purchaser becoming a content manger as amended by applicant. However, applicant fails to claim the purchase of the content further distributing the information received. Amendments made to the independent claims merely re-state limitations from the cancelled claims, which have been previously addressed and rejected with prior art.

15. As to applicants statement in the response in paragraph 1. Applicant states ONE of the problems to be solved is that protection of right (through payment) is given the original content provided. Examiner draws applicants attention to C. 9 I. 46-50 in which Wiser states "reporting to rights agents of purchases and other uses of media data for proper compensation of authors of fees and royalties of such uses. Therefore, Wiser is providing a solution to the problem stated by applicant. Examiner notes applicants intended use of the distribution of information intended use of the claimed invention must be evaluated to determine whether the recited purpose or intended use results in a structural difference (or, in the case of process claims, manipulative difference) between the claimed invention and the prior art.

16. Examiner further notes that applicant failed to overcome prior art rejections. Applicant stated they "reserved the right to challenge reference at a later date". In order to over a come a prior art rejection applicant must properly filed affidavit under 1.131 Affidavit or declaration of prior invention. As applicant failed to challenge prior art

reference it is deemed to read on the invention, therefore rejection is maintained as stated above.

17. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

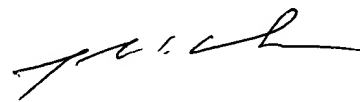
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Traci L. Smith whose telephone number is 571-272-6809. The examiner can normally be reached on Monday-Thursday 6:00 am-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TLS



JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600